



**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

Docket Number (Optional)

DURE-333 CON

First Named Inventor: Brodbeck, et al.

Art Unit: 1651

Application Number: 10/648,759

Examiner: Barnhart, Lora E.

Filed: 08/25/2003

Title:

IMPLANTABLE GEL COMPOSITIONS AND METHOD OF MANUFACTURE

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact  
Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.**

NOTE: A grantable petition requires the following items:

- (1) Petition fee.
- (2) Reply and/or issue fee.
- (3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
- (4) Adequate showing of the cause of unavoidable delay.

**1. Petition fee**

☐ Small entity – fee \$ \_\_\_\_\_ (37 CFR 1.17(l)). Applicant claims small entity status.  
See 37 CFR 1.27.

☒ Other than small entity – fee \$ 510.00 (37 CFR 1.17(l)).

**2. Reply and/or fee**

A The reply and/or fee to the above-noted Office action in the form of  
Response to Final Office Action, RCE (identify the type of reply):

☐ has been filed previously on \_\_\_\_\_

☒ is enclosed herewith.

B The issue fee of \$ \_\_\_\_\_

09/16/2008 HBLANCO 00000005 501953 10648750

☐ has been filed previously on \_\_\_\_\_

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☐ is enclosed herewith.

[Page 1 of 3]

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# **PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

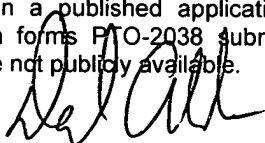
## **3. Terminal disclaimer with disclaimer fee**

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

## **4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.**

### **WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

David J. Abraham

Typed or printed name

Durect Corporation

Address

2 Results Way, Cupertino, CA 95014

Address



Date

39,554

Registration Number, if applicable

408-777-1417

Telephone Number

Enclosure ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☒ Additional sheets containing statements establishing unavoidable delay☒ Return Receipt Postcard, Transmittal, RCE

### **CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

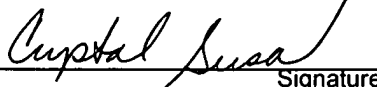
I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

09/12/2008

Date



Signature

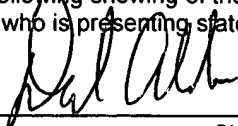
Crystal Susa

Typed or printed name of person signing certificate

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.



09/12/2008

Signature

Date

David J. Abraham

39,554

Typed or printed name

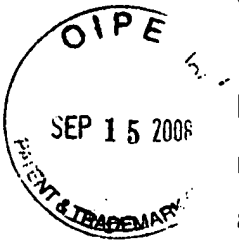
Registration Number, if applicable

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

PLEASE SEE ATTACHED SHEETS (5pp.).

*(Please attach additional sheets if additional space is needed.)*

The undersigned requests revival of this abandoned application pursuant to 37 CFR Sec. 1.137(a).



MPEP Sec. 7.11.03(c)(II)(C)(2), "Unavoidable Delay," states that "[d]ecisions on reviving abandoned applications on the basis of 'unavoidable' delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present."

*In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). The entire delay in filing the required reply in this Application from the due date for the reply until the filing of this petition was unavoidable.

The MPEP Sec. 7.11.03(c)(II)(C)(2) further states: "[a] delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;  
(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and  
(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care."

See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds sub nom.*, *Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

In brief, the required showing is met because (A) a docketing error is the cause of the delay at issue, (B) docketing of responses due in files prosecuted by the undersigned before the USPTO is a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee entrusted with the docketing function is highly trained and experienced such that reliance on the performance of that employee represents the exercise of due care. Additionally, the delay was discovered the day before the filing date of this petition, so the entire period of delay was unintentional.

The facts are described in more detail as follows.

The undersigned's employer, Durect Corporation ("Durect") acquired a very large patent estate from its previous owner. At the time, the estate was in spread out between numerous internal and external service providers, and the previous owner was unable to even provide a detailed docket that covered the entire estate. The estate was acquired in stages over a period from 12 December 2007 to May 22, 2008. Significant efforts to determine the actual scope of the estate,

and to reconstruct the files within the estate were needed, including contacting former outside counsel of the previous owner, and searches of public databases.

This effort took place over a period that began in December 2007, and continues as of the date of filing of this petition. As of the petition date, the undersigned believes that over 740 individual files make up the acquired patent estate, with significant work being needed to review each file.

On 10 September, an outside counsel of the previous owner of the estate sent a message to Durect stating that they had received a Notice of Abandonment in another Application within the patent estate. This prompted the undersigned to review the entire US portion of the patent estate. On 11 September, In the course of that review, the undersigned discovered that the present Application was abandoned for failure to reply to an Office Action (Final Rejection, with a mail date of 13 December 2007, and a Statutory Period for Response deadline of 13 June 2008).

A review of the file associated with this Application discovered that the Final Rejection had been received by the previous owner, but had not been properly docketed upon receipt of the file by Durect. A copy of the undersigned's docket is attached. It shows that no items had been docketed for 13 June 2008, the last day for the statutory period for responding to the Final Rejection. If the Final Response had been properly docketed, an entry noting the response due with a "Final" deadline would have appeared on the undersigned's docket.

The business routine established during acquisition of the patent estate that includes this Application was for the docketing specialist to review and docket all outstanding responses due in to the USPTO.

The Durect docketing specialist is highly trained and experienced, with 10 years of patent administrator experience (for US and foreign patent prosecution

practice). The Durect Docketing specialist assists with the preparation and receipt of USPTO correspondence, and with the processing of all newly acquired files to determine any due dates for responding to USPTO Office Actions. The Durect docketing specialist is trained to recognize, and is experienced in recognizing, papers received from the USPTO, and to understand the due dates for response associated with such papers. Furthermore, the Durect docketing specialist is trained and is experienced with the docketing software used to produce the undersigned's docket.

Apparently, due to a clerical error, the due date for the Final Rejection was not entered into the undersigned's docketing system, as noted above. As a result, a response to the Final Rejection was not filed within the statutory period for response, and the present Application became unavoidably abandoned.

The undersigned believes that revival is appropriate under 37 CFR Sec. 1.137(a) because the delay was unavoidable. If the error had come to light prior to the abandonment of this Application, then the undersigned would have immediately filed the Request for Continued Examination that accompanies this Petition.

Redacted

Wednesday, May 28, 2008

Due Date Due By Date

12-Jun-2008 14-Jun-2008 15-Jun-2008

Due Date Indicator	Action Due Action Type	Case Number/SubCase Country	Status Division	App Number Pat Number	App Date Iss Date	Attys
12-Jun-2008 Reminder	[REDACTED] [REDACTED]	DURE343 / Israel Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DJA [REDACTED]
14-Jun-2008 Due Date	[REDACTED]	DURE306 / 0 United States of America Title: [REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	DJA [REDACTED]
14-Jun-2008 Reminder	[REDACTED] [REDACTED]	Dure309 / Brazil Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DJA [REDACTED]
14-Jun-2008 Due Date	[REDACTED] [REDACTED]	DURE335 / Australia Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DJA [REDACTED]
14-Jun-2008 Reminder	[REDACTED] [REDACTED]	SBS102 / United States of America Title: [REDACTED]	Published	[REDACTED]	[REDACTED]	DJA [REDACTED]
15-Jun-2008 Reminder	[REDACTED] [REDACTED]	DURE019 / 01 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	TPM [REDACTED]
15-Jun-2008 Final	[REDACTED] [REDACTED]	DURE301 / 2 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DJA [REDACTED]
15-Jun-2008 Due Date	[REDACTED]	DURE325 / United States of America Title: [REDACTED]	Inactive	[REDACTED]	[REDACTED]	DJA [REDACTED]
15-Jun-2008 Reminder	[REDACTED] [REDACTED]	DURE332 / 12 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DJA [REDACTED]